

2841

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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application No.	09/823,391	
	Filing Date	March 30, 2001	
	First Named Inventor	Monte J. Rhoads	
	Group Art Unit	2841	
	Examiner Name	D. Levi	
Total Number of Pages in This Submission	8	Attorney Docket Number	42390P11044

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ENCLOSURES (check all that apply)		
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Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Kerry D. Tweet, Reg. No. 45,959 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	February 28, 2002

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Signature		Date	February 28, 2002



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FREE TRANSMITTAL for FY 2002 <i>Patent fees are subject to annual revision.</i>		Complete if Known	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.		Application Number	09/823,391
TOTAL AMOUNT OF PAYMENT (\$)		Filing Date	March 30, 2001
		First Named Inventor	Monte J. Rhoads
		Examiner Name	D. Levi
		Group/Art Unit	2841
		Attorney Docket No.	42390P11044

METHOD OF PAYMENT (check one)	
<input type="checkbox"/> Check	<input type="checkbox"/> Credit card
<input type="checkbox"/> Money Order	<input type="checkbox"/> Other
<input type="checkbox"/> None	
<input checked="" type="checkbox"/> Deposit Account	
Deposit Account Number	02-2666
Deposit Account Name	Blakely, Sokoloff, Taylor & Zafman LLP
The Commissioner is authorized to: (check all that apply)	
<input type="checkbox"/> Charge fee(s) indicated below	<input type="checkbox"/> Credit any overpayments
<input type="checkbox"/> Charge any additional fee(s) during the pendency of the application	
<input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account	

FEE CALCULATION					
1. BASIC FILING FEE					
Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	
SUBTOTAL (1)					

2. EXTRA CLAIM FEES					
Total Claims	39	**	=		
Independent Claims	5	.	=		
Multiple Dependent					
Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
103	18	203	9	Claims in excess of 20	
102	84	202	42	Independent claims in excess of 3	
104	280	204	140	Multiple Dependent claim, if not paid	
109	84	209	42	**Reissue independent claims over original patent	
110	18	210	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					

3. ADDITIONAL FEES					
Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet.	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for ex parte reexamination	
112	920 *	112	920 *	Requesting publication of SIR prior to Examiner action	
113	1,840 *	113	1,840 *	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	
Other fee (specify)					
* Reduced by Basic Filing Fee Paid					
SUBTOTAL (3)					

SUBMITTED BY		Complete (if applicable)	
Name (Print/Type)	Kerry D. Tweet	Registration No. (Attorney/Agent)	45,959
Signature		Telephone	(503) 684-6200
		Date	02/28/02

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
PATENT
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MAR 13 2002

In Re Application of:

Rhoads

Serial No.: 09/823,391

Filed: March 30, 2001

For: Riser Assembly and Method for
Coupling Peripheral Cards to a
Motherboard

Examiner: D. Levi

Group Art Unit: 2841

#6/Election
R. Rhoads
3/15/02

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Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO REQUIREMENT FOR RESTRICTION

**PROVISIONAL ELECTION WITH TRAVERSE AND
REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT**

Sir:

In response to the Office Action mailed January 29, 2002, Applicants respectfully
requests that the following election be entered and the following remarks considered.

REQUIREMENT FOR RESTRICTION

In the Office Action mailed January 29, 2002, the Examiner indicated (at page 2) that the Applicant is required to elect a single species for prosecution from the following disclosed species:

FIG. 5	SPECIES I
FIG. 6	SPECIES II
FIG. 7	SPECIES III

PROVISIONAL ELECTION WITH TRAVERSE

Applicant submits that the following claims correspond to each of the above-described species, respectively.

SPECIES I - Independent claim 1 and dependent claims 2, 3, and 5-7; independent claim 9 and dependent claims 10-14, 16-18, and 20; independent claim 21 and dependent claims 22-26, 28-30, and 32; independent claim 33 and dependent claims 34-35; as well as independent claim 36 and dependent claims 37-39.

SPECIES II – Dependent claims 8, 19, and 31.

SPECIES III – Dependent claims 4, 15, and 27.

It should be noted, however, that each of independent claims 1, 9, 21, 33, and 36 read upon each of FIGS. 5 through 7, respectively. Thus, in contrast to the Examiner's assertion that "no claims are generic" (Office Action, at page 2), Applicant respectfully submits that **each of independent claims 1, 9, 21, 33, and 36 is generic as to FIGS. 5 through 7, respectively.**

Applicants provisionally elect, with traverse, to prosecute the claims of SPECIES I, which species corresponds to claims 1-3, 5-7, 9-14, 16-18, 20-26, 28-30, 32-39, as noted above.

According to M.P.E.P. § 809.04, where the "requirement of restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is **entitled** to retain in the case claims to the nonelected invention or inventions." Although the reasons upon which the Examiner predicates the restriction requirement are unclear – as discussed in more detail below – the Applicant requests that

claims directed to the non-elected inventions – i.e., claims 8, 19, 31 (SPECIES II, FIG. 6) and claims 4, 15, and 27 (SPECIES III, FIG. 7) – be retained in the application, pursuant to M.P.E.P. § 809.04, if applicable.

REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT

As set forth above, Applicant provisionally elects to prosecute the claims of SPECIES I. However, applicant traverses the requirement for restriction and, pursuant to 37 C.F.R. § 1.143 and M.P.E.P. § 818.03, Applicant requests reconsideration of this restriction requirement for the reasons set forth below.

Examiner Has Failed to Satisfy the Criteria for Restriction

As set forth in M.P.E.P. § 803:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent . . . or distinct as claimed . . . ; **and**

(B) There must be a **serious burden on the examiner** if restriction is required. (emphasis added)

Section 803 goes on to state that “a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” The Applicant respectfully asserts that this case does not present a “serious burden” to the Examiner, and the Examiner has provided no evidence (e.g., separate classification, separate status in the art, different field of search) to the contrary. Because the claimed invention does not place a serious burden upon the Examiner, the requirement for restriction is improper.

Examiner Has Failed to Clearly State Why Restriction is Required

As set forth in M.P.E.P. § 814, the “particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to make the requirement clear.” Section 814 further states that it is “necessary to read all of the claims in order to determine what the claims cover. When doing this, the claims directed to each separate subject should be noted along with a statement of the subject matter to which they are drawn.” More importantly, as required by M.P.E.P. § 816, the “particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be **concisely** stated. **A mere statement of conclusion is inadequate.** The reasons upon which the conclusion is based should be given.”

Also, referring to M.P.E.P. § 808, it is stated that:

Every requirement to restrict has two aspects: (A) the reasons **(as distinguished from the mere statement of conclusion)** why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween . . .” (emphasis added).

In the Office Action, at page 2, the Examiner merely concludes that each of FIGS. 5, 6, and 7 includes a “patentably distinct species.” The Examiner does not set forth any particular reasons relied upon for the restriction requirement and, further, does not point out particular claim limitations and reasons why such limitations are considered to restrict the claims. In sum, because the Examiner has failed to comply with each of §§ 808, 814, and 816, it is unclear to the Applicant why a requirement for restriction is being made.

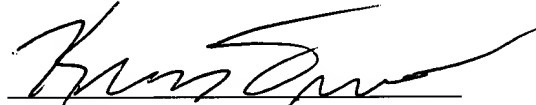
CONCLUSION

Any questions regarding this provisional election and request for reconsideration may be directed to the Applicant's undersigned attorney.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, L.L.P.

Date: February 28, 2002



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KDT/acf